

REMARKS

The present amendment is submitted in response to the Office Action dated January 9, 2008, which set a three-month period for response, making this amendment due by April 9, 2008.

Claims 1-15 are pending in this application.

In the Office Action, the specification was objected to for various informalities. Claims 1-15 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-15 were rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application '566 ("GB '566"). Claims 8-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over UK '566.

In the present amendment, the specification has been amended to add standard headings, to delete reference to the claims, and to add a cross reference to the related priority documents.

Claims 1-15 were amended to address the rejection under Section 112, second paragraph. Objected to claims 8 and 12 were rewritten as independent claims by eliminating the dependency on claim 1 and specifically reciting the relevant features.

Looking next at the substantive rejections of the claims, in particular, the rejection of claims 1-15 as anticipated by GB '566, the Applicants respectfully disagree that this reference anticipates the subject matter of the pending claims.

GB '566 discloses a tool holder 21, which is provided for receiving a drilling or chiseling tool 15. The tool holder 21a has an adapter 24, which is

arranged on the tool holder 21a such that it is not detachable from it or mountable to it.

In contrast, the present invention relates to a tool holder for receiving an adapter 12 AND a tool 10. The adapter 12 is inserted therefore into the tool holder. With a rotary hammer drill 10 according to GB '566, however, it is **not** disclosed that the adapter 24 is ***removed from or inserted into the tool holder***.

In addition, the adapter 24 is embodied as one piece with the main body 22 of the tool holder 21 (see GB '566, page 3, paragraph 2 and Figs. 1 and 2). Furthermore, the drilling hammer 10 has a receiver 20 for accommodating the tool holder 21a together with the adapter 24. Receiving or accommodating the adapter 24 in the tool holder 21a, however, does not take place.

Therefore, independent claims 1, 8 and 12 include features that are not disclosed in GB '566 so that the rejection under Section 102 must be withdrawn. To support the rejection of a claim under Section 102, the cited reference must disclose each and every element of the rejected claims with sufficient clarity to prove its existence in the prior art. ***Motorola, Inc., v. Interdigital Tech. Corp.***, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Here, this standard has not been met.

Turning now to the rejection of claims 8-15 as obvious over GB '566, this reference describes a tool holder 21a, which is removable from a drilling hammer 10. In this connection, the tool holder 21a has an adapter 24, which is formed as one piece on a main body 22 of the tool holder 21a and is not arranged to be mountable on and removable from the tool holder 21a (GB '566, Figs. 1 and 2).

Starting from this prior art, the present invention addresses the technical object of providing a tool holder that enables a particularly exact guiding of a tool with a constructively simple receiver for an adapter.

The present invention resolves this object by providing the tool holder for receiving a drilling hammer and/or chiseling tool AND an adapter, in which means for reducing the movability of the adapter in the mounted state relative to the movability of the drilling hammer and/or chiseling tool in the mounted state is provided. In this manner, the particular advantages of the adapter within the tool holder can be utilized.

The Applicants respectfully submit that GB '566 provides no teaching or suggestion that would lead the practitioner to the present invention and that the Examiner has provided no specific or explicit grounds for why the practitioner could be lead to the invention by this reference. Indeed, the disclosure of GB '566 teaches away from the present invention, because in this reference, the adapter 24 has the purpose of operatively connecting the tool holder 21a with a hammer tube 11 of the drilling hammer 10. For this purpose, the adapter 24 is inserted together with the tool holder 21a into a receiver 20.

In contrast, with the present invention, the adapter 12 has the function of creating a working connection between a tool and the tool holder, whereby the adapter 24 is inserted for this purpose into the tool holder.

Furthermore, GB '566 teaches providing an adapter 21b that is separated from a tool holder 21a (see GB '566, Fig. 3), which can be used alternatively to

the tool holder 21a, which directly contracts and teaches away from the present invention as defined in the pending claims.

Therefore, GB '566 cannot be an appropriate reference either under, MPEP section 2131, which indicates that to anticipate a claim a reference must teach every element of the claim in as complete detail as is contained in Applicant's claim, or under MPEP section 2143.03, since not all of Applicant's claim limitations are taught or suggested.

For the reasons set forth above, the Applicants respectfully submit that claims 1-15 are patentable over the cited art. The Applicants further request withdrawal of the rejections and reconsideration and allowance of the claims as herein amended.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,
/Michael J. Striker/
Michael J. Striker
Attorney for Applicant(s)
Reg. No. 27233
103 East Neck Road
Huntington, New York 11743
631-549-4700